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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,895	12/10/2003	Cheng-Le Zhao	IN-9524	8613
54308	7590	10/26/2005		
BASF AG CARL-BOSCH-STRASSE 38 6700 LUDWIGSHAFEN THEINLAND-PFATZ D-67056, 67056 GERMANY			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/733,895

Applicant(s)

ZHAO, CHENG-LE

Examiner

William K. Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on August 25, 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/733,895 is acceptable and a RCE has been established. An action on the RCE follows. Claims 1-5, 7-14 are pending.
2. In view of amendment filed August 25, 2005, the rejection of Claims 1-4, 9, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rokowski et al. (US 5,534,310) is withdrawn.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-5, 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rokowski et al. (US 5,534,310).

*The invention of claims 1-5, 7-14 relates to a **method of making a composition** comprising reacting, in a reactor,*

- a. a **non-halogenated acetoacetate** group containing **monomer**,*
- b. at least one **additional monomer**, and*
- c. a **base**,*

*wherein at least a **portion of the base is fed to the reactor during reaction and less than 50% of the base is present in the reactor at the start of the reacting step, and wherein the base is added during the reacting step in an amount such that the pH is not higher than 7 and such that the aqueous polymer dispersion viscosity is lower than an aqueous polymer dispersion prepared in the same way but without the base added during the reacting step.***

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Rokowski et al. (col. 12-13, example 3 ; col. 17, claim 1) disclose a method of making a composition comprising reacting in a reactor, a non-halogenated acetoacetate group containing monomer in the presence of at least one additional monomer, and a base. According to example 3 of Rokowski et al., the base was added into the reactor during the polymerization process.

The difference between the invention of claims 1-5, 7-14 and Rokowski et al. is that Rokowski et al. are silent on a process comprising specific conditions on how the base is added as claimed.

Although Rokowski et al. are silent on the specific conditions on how the base is added, applicants must recognize that the process as taught by Rokowski et al. (col. 2, line 5-19; col. 11, line 60 to col. 14, line 67) generically encompasses the specific conditions on how the base is added as claimed. Motivated by the expectation of success of preparing a latex binder suitable for producing high gloss coating on weathered substrates and a method for producing such coatings (abstract), it would have been obvious to one of ordinary skill in art to perform routine engineering process to arrive the specific conditions as claimed.

### ***Response to Arguments***

Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive. Applicants argue that Rokowski et al. is silent on lowering the aqueous polymer dispersion viscosity. However, applicants must recognize that the lowering of the polymer dispersion viscosity is property that is inherent to the obviated steps in view of Rokowski et al. To overcome the rejection set forth, applicants should submit comparative data to show the criticality of the instant claimed specific conditions on how the base is added over the prior art of Rokowski et al.

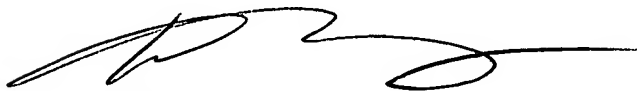
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung

Primary Examiner

October 20, 2005

**WILLIAM K. CHEUNG**  
**PRIMARY EXAMINER**